

REMARKS

This is in response to the Office Action mailed on October 7, 2005, in which claims 1, 5-10 and 12-29 were rejected. The drawings were objected to under 37 C.F.R. 1.83(a). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. (U.S. Patent Application 2002/0112395 A1). Claims 1, 5, 10, 12-17, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling (U.S. Patent Number 2,264,875) in view of Byom (U.S. Patent Number 5,253,448). Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling as modified by Byom as applied to claim 1, and further in view of Marsh. Claims 8, 9, 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling in view of Byom as applied to claim 1, and further in view of Nelson (U.S. Patent Number 6,185,862). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling in view of Byom, and further in view of Marsh and Nelson. Claims 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh in view of Nelson. Claims 12-14 and 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh.

The present invention is a device and method for removing a tick or other pest from a body surface of a human or animal host. The device is configured to be applied over the pest and the surrounding body surface such that the device conforms to and adheres to both. The device smothers the pest such that the pest becomes irritated or suffocated. As a result, the pest releases from the body surface. The release tab is used to peel the device from the body surface, carrying the pest with it.

The present invention is different both in its configuration and its method of use, as compared to the above references cited by the Examiner. First, Marsh discloses a device in the form of modified tweezers that grasp the pest and pull the pest away from the point of attachment. Grueling and Byom both disclose a device that uses fly-paper for trapping an insect when the insect lands on the fly-paper. Nelson discloses an adhesive sheet in which the adhesive is applied to an insect that is on the skin to remove the insect from the skin, while minimizing contact between the skin and the adhesive. None of

the references cited by the Examiner are configured to contact a pest and the surface surrounding the pest, using a skin-friendly adhesive layer, such that the pest will be smothered and release from the surface.

All of the independent claims emphasize these unique aspects of the invention, which are not taught or suggested by any of the above references. Claims 1, 5-10 and 12-29 are allowable and the rejections should be withdrawn.

Drawings

The drawings were objected to under 37 C.F.R. 1.83(a). A replacement set of drawings has been submitted. The only change from the original drawings is the addition of Figure 4A.

Figure 4A shows adhesive side 214 of pest removal device 200 sticking to the pest 228 and a surrounding surface 230 on which the pest 228 is touching. Figure 4A illustrates that pest removal device 200 covers and conforms to body surface 230 and pest 228. Figure 4A does not add new matter since what is shown in Figure 4A is described in the specification. (See Appl. at p. 8, l. 25 - p. 9, l. 6.) With this Amendment, the objection to the drawings should be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh. The Examiner states that “Marsh does show equivalent structure and that merely, the method of use is slightly different. However Marsh show the structure to perform that use and it would have been obvious to use Marsh in the manner recited since the function is the same and no stated problem was solved.” (Office Action 10/7/05 at p. 9, ¶ 9.) Respectfully, this statement by the Examiner is incorrect. In the Background, Marsh states “the force applied to remove the tick may result in the head breaking off and remaining attached to the host with no feasible means of removing it.” (Marsh at p. 1, ¶ 4.) Further, in the Detailed Description, Marsh states “[t]he roughened surface (10) facilitates the final step of grasping and pulling the tick away from the point of attachment. If excessive force is applied, the device separates from

the tick. If the appropriate amount of steady force is applied, the tick is pulled from the skin and the tick remains attached to the device for disposal....the adhesive used is selected so that its adhesion strength is such that the device will detach from the body of the tick before the head is broken away from the body.” (Marsh at pp. 1-2, ¶¶ 14-15.) Marsh articulates the problem of completely removing the imbedded tick without parts of the tick breaking off and remaining in the skin.

The present application also identifies the problem associated with using a device like the device disclosed in Marsh. “Tweezers and forceps have been used to remove burrowed insects from the skin of the host. A problem with using this type of removal device is that if the insect has attached itself to the host, then a portion of the insect may break off and remain at the burrow site when removing the insect.” (Appl. at p. 2, ll. 9-12.) The invention disclosed here offers an alternative structure to solve this problem. “If the adhesive side 214 is penetrated or imbedded with an antiseptic solution, the pest 228 may become irritated. This irritation may cause the pest 228 imbedded in the surrounding surface 230 to detach. Additionally, if the pest removal 200 device is constructed of a resilient foam material, it compresses and surrounds the pest 228 thereby suffocating the pest 228 causing the pest to release from the surrounding surface 230.” (Appl. at p. 9, ll. 1-6.)

Claim 23 requires means for securing the pest to the first side of the substrate by adhering the substrate to the body surface so that the substrate covers and conforms to the body surface and the pest. The Examiner states that “Marsh does not disclose that the pest removal device is placed on the skin of a body, but shows the device covering the pest at a point above the skin of a body. However, it would have been obvious that the device could be placed in contact with the skin of a body to obtain a more secure grasp of the pest by the adhesive.” (Office Action 10/7/05 at pp. 3-4, ¶ 2.)

In the disclosed invention, the device does not contact the body in order to obtain a more secure grasp of the pest by the adhesive. The device contacts the body so that the device completely surrounds the pest in order that an antiseptic solution will irritate or suffocate the pest. (See Appl. at p. 9, ll. 1-6.) In either event, the device causes the pest to release itself from the surface. In contrast, the Marsh

device is “placed over the tick so that the tick is within the ‘V’ formed by the folded adhesive surface (4) of the backing....The user continues to apply pressure to both sides of the backing, continuing to fold the device at the central folding axis against the body of the tick.” (Marsh at p. 1, ¶ 14.) Marsh teaches a different structure (see Fig. 4) to perform a different function, which is grasping the pest and pulling it out.

Because Marsh teaches a different structure to perform a different function, it is not obvious how the Marsh device could be used to “cover and conform to the body surface and the pest”, as required by claim 23. As such, claim 23 is patentable over Marsh.

Claims 1, 5, 10, 12-17, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling in view of Byom

Grueling as modified by Byom does not teach or suggest attaching the device to human skin or animal skin. Grueling discloses a “shelf-like surface upon which the fly-catching adhesive is spread.” (col. 2, ll. 36-37) Byom discloses “an improved adhesive ribbon for catching flies.” (col. 1, ll. 7-8) In fact, because Grueling and Byom both include an adhesive used for catching flies, these two references, alone or in combination, teach away from attaching the device to a body surface of an animal or human, since it would not be desirable to place adhesive used for fly paper on a body surface.

The Examiner stated that Applicant submitted no evidence to support the proposition that the type of adhesive used on fly-catching paper is not skin-friendly. (See Office Action 10/7/05 at pp. 9-10, ¶ 9.) Both Grueling and Byom disclose that fly-catching paper is not skin-friendly. Byom, in describing a conventional adhesive ribbon for catching flies, states “[w]hen it is used, its adhesive agent sticks to a finger, and **so it is unpleasant and unsanitary.**” (col. 1, ll. 20-21) Grueling states: “[a]dhesively coated fly-catching paper, whether in the sheet form such as is commonly laid flat upon a table, shelf or other horizontal support, or in the form of a tape or ribbon designed to be suspended from an elevated support, for example a lighting fixture, is **an extremely undesirable article except from a**

standpoint of its ability to entangle flies.....it must be carefully handled to avoid soiling the fingers.” (col. 1, ll. 4-14)

Claim 1 requires that “the main body is configured to conform to and attach to the surface to cover and smother the pest”. As discussed above, Grueling and Byom teach away from attaching the device to a body surface of an animal or human. In addition, claim 1 requires that “the adhesive layer is composed of a material that is not irritating to human skin or animal skin.” Since both Grueling and Byom disclose an adhesive used for fly paper, Grueling in view of Byom does not make it obvious to employ an adhesive layer that is skin-friendly. Because Grueling and Byom do not teach or suggest these claim limitations of claim 1, claim 1 is patentable over Grueling in view of Byom.

Claims 5 and 10 depend from independent claim 1 and contain all the limitations of claim 1. Since claim 1 is allowable, claims 5 and 10 are also allowable.

Claim 12 requires that “the main body is substantially flat and the engagement side is attachable to the surface by the adhesive layer and conformable to the surface to cover and smother the pest.” As discussed above for claim 1, because Grueling and Byom do not teach or suggest attaching the engagement side to the surface of a body of an animal or human, claim 12 is patentable over Grueling in view of Byom. Moreover, claim 12 requires “an engagement side covered with a hypoallergenic pressure-sensitive adhesive layer”. As also discussed above for claim 1, Grueling in view of Byom teaches avoiding contact of the adhesive with the skin because the adhesive is a type used for catching flies and is not skin friendly. As such, Grueling in view of Byom does not make it obvious to cover the engagement side with a hypoallergenic pressure-sensitive adhesive layer. Claim 12 is patentable over Grueling in view of Byom.

Claims 13-17 depend from independent claim 12 and contain all the limitations of claim 12. Since claim 12 is allowable, claims 13-17 are also allowable.

Claim 19 requires that "the substrate is configured to be applied to and conform to the body surface to cover and smother the pest." Claim 19 also requires "a hypoallergenic pressure-sensitive adhesive layer covering the engagement portion of the first side to contact the pest and releasably attach the engagement portion to the body surface." The discussion above regarding claim 12 also applies to claim 19. Grueling and Byom do not teach or suggest applying the substrate to the body surface of an animal or human. Grueling and Byom also do not teach or suggest covering the engagement portion with a hypoallergenic pressure-sensitive adhesive layer. As such, claim 19 is patentable over Grueling in view of Byom.

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling as modified by Byom as applied to claim 1, and further in view of Marsh. Claims 6 and 7 depend from independent claim 1 and contain all the limitations of claim 1. Since claim 1 is allowable, claims 6 and 7 are also allowable.

Claims 8, 9, 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling in view of Byom as applied to claim 1, and further in view of Nelson.

Claims 8 and 9 depend from independent claim 1 and contain all the limitations of claim 1. Since claim 1 is allowable, claims 8 and 9 are also allowable. Claim 18 depends from independent claim 12 and contains all the limitations of claim 12. Since claim 12 is allowable, claim 18 is also allowable.

Claim 19 is patentable over Grueling in view of Byom, as discussed above. Nelson discloses "a device for capturing insects or other small pests" (col. 1, ll. 8-9) and teaches "to avoid a strong bond between the surface and the adhesive. The presence of the trapped insect between the substrate and the surface further serves to minimize the contact between the adhesive and the surface and accordingly the bonding between the adhesive and the surface is diminished." (col. 3, l. 67 - col. 4, l. 5) Nelson teaches to avoid contact between the surface and the adhesive. Nelson, like Grueling and Byom, teaches away

from using "a hypoallergenic pressure-sensitive adhesive layer" and a substrate "configured to be applied to and conform to the body surface to cover and smother the pest", as required by claim 19. As such, the addition of Nelson to Grueling in view of Byom does not teach or suggest the claim limitations of claim 19, and claim 19 is patentable over these references.

Claims 20-22 depend from independent claim 19 and contain all the limitations of claim 19. Since claim 19 is allowable claims 20-22 are also allowable.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grueling in view of Byom, and further in view of Marsh and Nelson.

As amended, claim 24 requires "an adhesive layer covering the engagement portion of the first surface to contact the pest and the body surface surrounding the pest, wherein the pest removal device is substantially flat and is flush with the body surface when in use to remove a pest, and the adhesive layer is skin-friendly such that the pest removal device can be left on a body surface of an animal or human for a sufficient period of time to cause the pest to release itself but without irritating the body surface". (See Appl. p. 8, ll. 23-28, p. 9, ll. 1-12 and FIG. 4.)

As similarly stated above regarding claim 1, Grueling and Byom teach away from the requirement of claim 24 that the adhesive layer is skin-friendly such that it can be left on the body surface of an animal or human. Neither Marsh nor Nelson teaches or suggests this claim limitation. As cited above, Nelson teaches "to avoid a strong bond between the surface and the adhesive." (Nelson at col. 4, l. 1.) It is improper to use Nelson as teaching or suggesting a device that uses an adhesive layer that is "skin-friendly such that the device can be left on a body surface of an animal or human for a sufficient period of time to cause the pest to release itself but without irritating the body surface", when in fact Nelson teaches the opposite, which is to avoid contact with the body surface.

Marsh does not teach that the pest removal device could be left on the surface "for a sufficient period of time to cause the pest to release itself", as required by amended claim 24. In fact, in

Marsh, the device has minimal contact with the surface because the pest is being grasped and pulled away from the surface. (See Marsh at p. 1, ¶ 14.) In addition, Marsh does not disclose a device that is “substantially flat and is flush with the body surface when in use to remove a pest”, as required by amended claim 24.

Furthermore, it is improper to combine Marsh with Grueling, Byom and Nelson since the Marsh device is a modified form of tweezers and removes the pest by “*grasping and pulling* the tick away from the point of attachment.” (Marsh at p. 1, ¶ 14 (emphasis added)). In contrast, Grueling and Byom disclose fly paper coated with adhesive that the pest lands onto, and Nelson discloses a flat adhesive sheet that is pressed against the pest (but not the surrounding skin) such that the pest adheres to the sheet.

Because none of the above cited references teach or suggest the above limitations in amended claim 24, claim 24 is patentable over these references.

Claims 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh in view of Nelson. Claims 25-29 are method of use claims.

Nelson teaches away from attaching the pest removal device to the body surface of an animal or human. Nelson discloses a device that is “pressed firmly against an intended insect” (col. 2, l. 10). Nelson further discloses that the user “tries to avoid a strong bond between the surface and the adhesive. The presence of the trapped insect between the substrate and the surface further serves to minimize the contact between the adhesive and the surface and accordingly the bonding between the adhesive and the surface is diminished.” (col. 3, l. 67 - col. 4, l. 5) Nelson does not teach or suggest the step of “securing the pest removal device to the pest and the body surface for a time sufficient to cause the pest to release itself from the surface”, as required in claim 25.

Moreover, it is improper to combine the Marsh device with the Nelson device because Nelson uses a flat, adhesive surface for the insect to adhere to and Marsh operates like tweezers by grasping and pulling the pest out. Because Marsh and Nelson do not teach a method of “securing the pest

removal device to the pest and the body surface for a time sufficient to cause the pest to release itself from the surface", claim 25 is patentable over Marsh in view of Nelson.

Claims 26-29 depend from independent claim 25 and contain all the limitations of claim 25. Since claim 25 is allowable, claims 26-29 are also allowable.

Claims 12-14 and 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh. The Examiner states that "[t]he main body is substantially flat and shows the structure capable of being attachable to the surface by the adhesive layer to cover and smother the pest." (Office Action at p. 8, ¶ 8.)

The Marsh device is not "conformable to the surface to cover and smother the pest", as required by claim 12. The Marsh device is configured as a pincer or tweezers, to grasp and pull the pest away from the surface. (See Marsh at p. 1, ¶ 14.) The Marsh device is not capable of smothering the pest.

Moreover, claim 12 requires "a release tab extending from the outer edge of the main body, wherein the release tab is graspable to apply a pulling force to the outer edge of the main body and peel the main body off the surface to which the main body is attached." The Examiner states that Marsh shows a release tab that peels the main body off the surface. (See Office Action at p. 8, ¶ 8.) First, the Marsh device is not configured to attach to the surface and in fact, has minimal contact with the surface. Second, the tab in Marsh is not used to "**peel** the main body off the surface to which the main body is attached". The tab is not positioned on the Marsh device in a manner that the tab could peel the main body off of the surface. Rather, the tab disclosed in Marsh is used to aid the user in using the device like tweezers - the tab is grasped by the user to apply pressure to both sides of backing (2) in order to bring the two sides toward one another to grasp and pull the tick away from the point of attachment. (See Marsh at p. 1, ¶ 14.)

Because Marsh does not teach or suggest the above claim limitations of claim 12, claim 12 is patentable over Marsh.

Claims 13-14 and 16-17 depend from independent claim 12 and contain all the limitations of claim 12. Since claim 12 is allowable, claims 13-14 and 16-17 are also allowable.

CONCLUSION

With the above amendments and remarks, the application is now in condition for allowance. Notice to that effect is respectfully requested.

Respectfully submitted,

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